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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,501	02/23/2004	Anjali Abhimanyu Patil	Rev 03-25	2236

7590 05/02/2007  
Julie Blackburn  
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EXAMINER
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RAMACHANDRAN, UMAMAHESWARI

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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05/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/784,501

**Applicant(s)**

PATIL ET AL.

**Examiner**

Umamaheswari Ramachandran

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/11/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election of group I, claims 1-25 (in part) drawn to a cosmetic composition containing a silicone resin polymer comprised of M units in combination with Q and a method for improving the finish of a cosmetic composition, by formulating such composition with a silicone resin comprised of M units in combination with Q in the reply filed on Mar 23 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Thus the restriction requirement elected is made final. Claims 1-25 are pending.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/367301 ('301). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 13-25 are

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generic to all that is recited in claims 1-20 of '301. That is, claims 1 and 13-25 of the instant application fall entirely within the scope of claims 1-20 of the co-pending application '301 or, in other words, claims 1-20 are anticipated by claims 1 and 13-25 of the instant invention. Specifically, the silicone resin polymer and film-forming polymers of '301 appear to be the same polymers as recited in the instant claims. The copending application also claims cosmetic compositions containing oils and additives.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto (Sho 61-158913).

Yamamoto teaches a facial cosmetics such as foundation, lipstick containing R<sub>3</sub>SiO<sub>2</sub> units and SiO<sub>2</sub> units present in a molar ratio from 0.5/1 to 1.5/1 and volatile silicone oils (see Abstract, examples).

Claims 1-3, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiroshi et al. (Kokai 86-65809).

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Hiroshi teaches a facial cosmetics such as foundation, lipstick containing R3SiO2 units and SiO2 units present in a molar ratio from 0.5/1 to 1.5/1 and volatile silicone oils (see Abstract, examples).

Claims 1-8, 11, 18, 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Berthiaume et al. (U.S. 5,684,112).

Berthiaume et al. teaches a MQ silicone resin in cosmetic composition such as color cosmetics, skin cosmetics. The number of M units ranging from 0-4 when number of Q units is set to one is being taught by the reference. (see Abstract, col. 3, lines 45-67, col. 4, lines 1-8). The reference further teaches that the low viscosity fluid MQ resins are useful in a variety of cosmetic and personal care applications and impart improved shine on hair and increased volume or body (col. 4, lines 13-15, col. 6, lines 3-6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 12-17, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berthiaume et al. (U.S. 5,684,112) in view of Luo et al. (US 2004/0141933).

Berthiaume et al.'s teachings discussed as above. The reference teaches that MQ resins are low viscosity fluids with a viscosity range of 50-1000 cs but the viscosity

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range, all other chemical factors being constant tends to vary with the molecular weight of the radicals being substituted into the various pendant groups constituting the MQ resin (col. 6, lines 3-7).

The reference do not teach a composition comprising a MQ resin with another film forming polymer, or oil or a rheological additive. The reference does not teach hydroxyl groups functional groups in the silicone resin polymer or the polymer to be a solid or semi-solid.

Luo et al. teach lip products that utilize its film-forming component a pressure sensitive adhesive (PSA) compound that is a reaction product between a silica dioxide, or derivatives thereof, and a silanol-endblocked polydiorganosiloxane fluid having a viscosity of from about 1,000 to about 200,000 cs. The reference teaches that any silica derivative can be used, provided it has sufficient hydroxy radical density to react with the silanol-endblocked diorganosiloxane. The reference teaches the preferred PSA compounds as non-flowable solids (para 005 lines 1-15). The reference teach topical cosmetic compositions that are long-wearing such as lipsticks and lip balms or glosses containing 1-50% of a film-forming silicone polymer such as BIO-PSA® polymers in combination with other silicone polymers such as organopolysiloxane elastomers and silicone esters, pigments, UV absorbers (e.g. titanium dioxide, zinc oxide), oils (cyclic and linear silicones), a rheological modifier or gellants such as organopolysiloxane elastomers, ethylene/methacrylic acid copolymer, ethylene/acrylic acid copolymer, organo-clays (para 001, 004, 005, 006, 0010). The reference teaches that the resulting

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lip product provides a long-wearing film and in combination with the top coat provides a shiny attractive lip color (para 004, lines 13-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add another film forming polymer, or oil or rheological additives in a composition comprising MQ resin. The motivation to do so is taught by Luo et al. The reference teaches a composition comprising a silicone polymer resin in combination with other silicone polymers such as organopolysiloxane elastomers, ethylene/methacrylic acid copolymer, ethylene/acrylic acid copolymer, cyclic and linear silicone oils and organo-clays. One of ordinary skill in the art would have been motivated to add another film forming polymer, oil or rheological additive to MQ resin composition because Luo et al. teaches that addition of such compounds increases the aesthetics of the product. The reference further teaches that viscosity can be modified depending on the gellant amounts to produce a flowable, soft gel product and oil can act as a carrier.

Berthiaume et al. and Luo do not teach the silicone resin polymer to be semi-solid at room temperature.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have a semi-solid silicone resin polymer in the cosmetic composition comprising an MQ resin because Berthiaume et al. teaches that viscosity vary with the molecular weight of the radicals being substituted into the various pendant groups constituting the MQ resin. Hence one of ordinary skill in the art would have been motivated to vary the viscosity range such that the silicone resin polymer in the

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cosmetic composition to be semi-solid or fluid depending on the need of the cosmetic formulation such as hair care, skin care etc.

### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umamaheswari Ramachandran whose telephone number is 571-272-9926. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER